

Remarks

Claims 6-10 are canceled.

Claims 1-5 are now pending and are the only claims in this application.

An Appeal Brief for this application was filed May 27, 2003.

A Notice of Non-Compliance with Rule 192(c) was mailed from the PTO on August 12, 2003.

The Examiner is kindly requested to withdraw the appeal and to reopen prosecution in accordance with Rule 114(d).

Applicants cancel process claims 6-10 to simplify the issues for this application. Applicants reserve the right to file a continuation application aimed at process claims 6-10.

Claims 1-5 are aimed at certain hindered amine compounds.

Applicants offer the following summary for clarification. Ciba Specialty Chemicals owns five patent families aimed at pulp and paper stabilization. These are:

Family 1 : Inhibition of Pulp and Paper Yellowing Using Nitroxides, Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21393/21414/P2/CGC 1946/CGC 1948

This family is aimed at hindered amine compounds towards the stabilization of pulp or paper.

App. No. 09/119,567, filed July 20, 1998, now U.S. Pat. No. 6,254,724

Contains claims to pulp or paper compositions comprising hindered hydroxylamine compounds or their salts, and to a process of stabilizing pulp or paper with said compounds.

App. No. 09/573,401, filed May 18, 2000, now U.S. Pat. No. 6,500,303

A divisional of app. No. 09/119,567, contains claims to certain hindered nitroxide compounds and hindered hydroxylamine salts.

App. No. 09/974,382, filed Oct. 10, 2001, now U.S. Pat. No. 6,447,644

A divisional of app. No. 09/573,401, contains claims to paper compositions comprising hindered nitroxyl compounds and to a process of stabilizing paper with said compounds.

Family 2 : Inhibition of Pulp and Paper Yellowing Using Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21855/P2/CGC 2002

This family is aimed at dialkylhydroxylamines towards the stabilization of pulp or paper.

App. No. 09/234,253, filed Jan. 20, 1999

This application contains claims toward pulp or paper compositions comprising dialkyl- or substituted dialkylhydroxylamine compounds or their corresponding salts.

App. No. 10/140,531, filed May 7, 2002

A divisional of 09/234,253. Contains claims towards a process of stabilizing pulp or paper with dialkyl- or substituted dialkylhydroxylamine compounds or their corresponding salts.

Family 3 : Inhibition of Pulp and Paper Yellowing Using Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3-21961/P2/CGC 2012

This family is aimed at dialkylhydroxylamines towards the stabilization of chemical pulp or paper.

App. No. 09/481,665, filed Jan. 12, 2000, now U.S. Pat. No. 6,599,326

This issued patent contains claims to chemical pulp or paper comprising dialkylhydroxylamines or substituted dialkylhydroxylamine compounds or their corresponding salts, and to a process of stabilizing chemical pulp or paper with said compounds.

Family 4 : Inhibition of Pulp and Paper Yellowing Using Nitroxides, Hydroxylamines and Other Coadditives

Attorney Docket No. PW/3- 21962/P2/CGC 2013

This family is aimed at hindered amine compounds towards the stabilization of chemical pulp or paper.

App. No. 09/483,017, filed Jan. 13, 2000

Contains claims towards chemical pulp or paper compositions comprising hindered nitroxyl compounds, hindered hydroxylamine compounds, and hindered hydroxylamine salts, and to a process of stabilizing chemical pulp or paper with said compounds.

Family 5 : Chlorhydrin and Cationic Hindered Amine Compounds Having High Affinity for Pulp or Paper

Attorney Docket No. PW/3-22082/P1/CGC 2041

This family is aimed at chlorhydrin or cationic compounds having nitroxide or hydroxylamine moieties for the stabilization of pulp or paper.

09/658,924, filed Sep. 11, 2000

The present application, original claims are to chlorhydrin or cationic hindered amine compounds, and to a process of stabilizing pulp or paper with said compounds ; now only contains claims to compounds.

Family 6 : Stabilization of Wood Substrates

Attorney Docket No. CO/21-21511/A

This family is aimed at the stabilization of wood with hindered amine compounds.

App. No. 09/267,472, filed March 11, 1999, now U.S. Pat. No. 6,187,387

Contains claims to a method of protecting wood with certain hindered nitroxyl compounds, hindered hydroxylamine compounds, or hydroxylamine salt compounds.

As the present claims are only to compounds, there is no possible overlap with claims of the above issued U.S. Patents or patent applications. U.S. Pat. No. 6,500,303 contains claims to certain hindered nitroxide and hydroxylamine salt compounds ; there is no overlap of the compounds of the present claims with those of this issued patent.

Further, there is no overlap of the compounds of the present claims with compounds of formulae A to EE and A* to EE* of the patent family 1 above, that is the disclosure of U.S. Pat. No. 6,254,724 (equivalent to WO 99/05108).

Claim Rejections

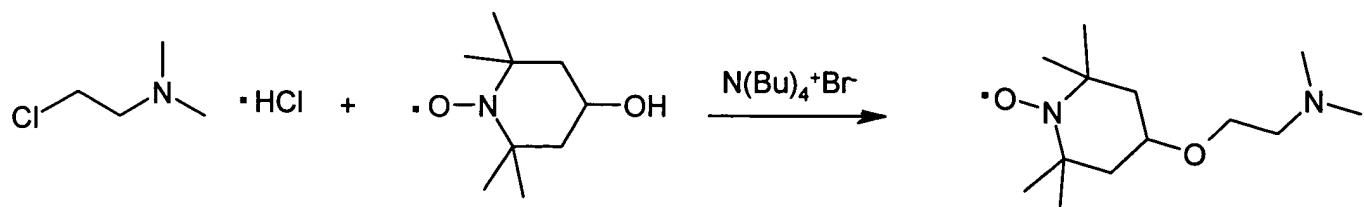
Claims 1-10 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Amendment filed September 17, 2001 is objected to under 35 USC 132 as introducing new matter into the specification.

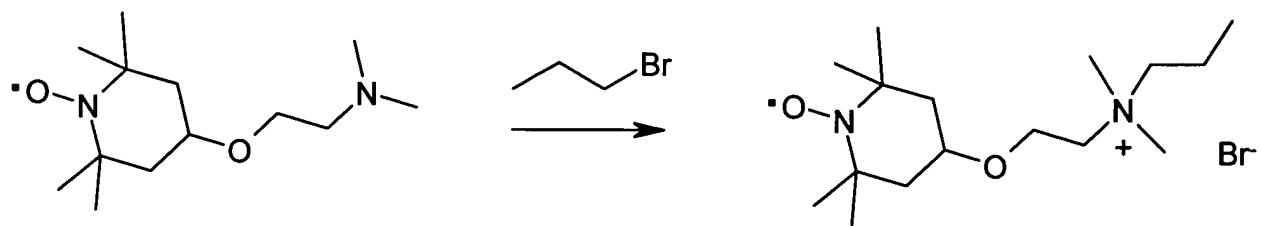
Said Amendment corrected the nomenclature of the compound of working Example 18 on page 30 of the specification. The Amendment does not add new matter, rather it corrects a nomenclature error. As the compound of Example 18 is stated to be prepared according to Example 16 replacing propyl bromide with 1,6-dibromohexane and provides a compound with a mass of 651, it is apparent that the original nomenclature was incorrect. The term "propyl" was deleted and the correct term "ethyl" was inserted.

For the convenience of the Examiner, a schematic of present working Examples 14, 16 and 18 are given here:

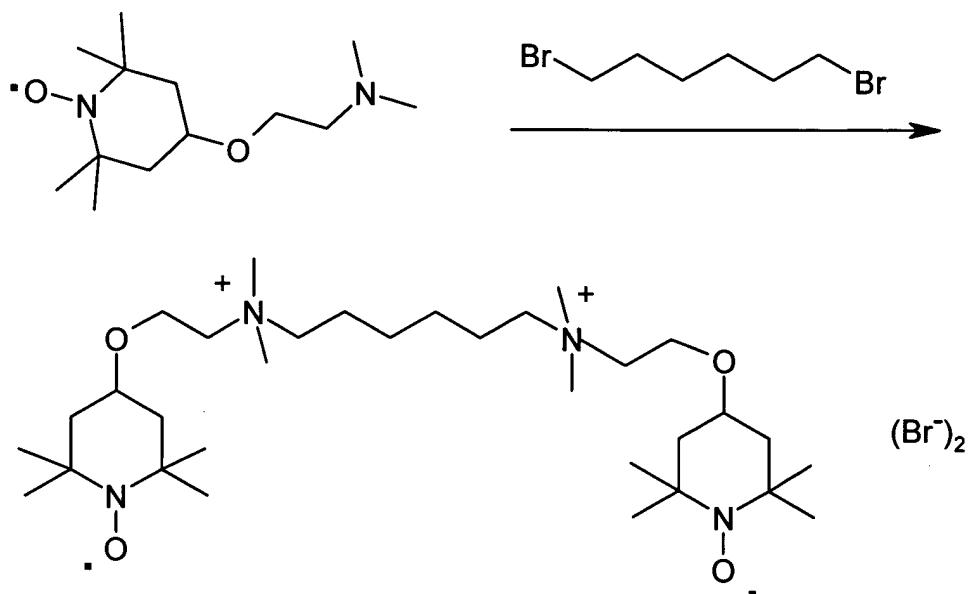
Example 14



Example 16



Example 18



A Declaration under Rule 132 by Dr. Glen Cunkle was attached to the Response filed October 7, 2002, in which it is stated that the compound N,N,N',N'-tetramethyl-N,N'-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide is the only compound obtained by the procedure of present Example 18.

The inventors therefore, certainly had possession of N,N,N',N'-tetramethyl-N,N'-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide at the time the application was filed.

Applicants submit that the amendment correcting the name of the compound of working Example 18 does not introduce new matter, but rather simply harmonizes the disclosure of the specification.

Further, such amendment does not change the scope of the claims when read in view of the specification. Both the incorrect "propyl" and the correct "ethyl" compounds fall within the scope of generic formula VIII of claim 1.

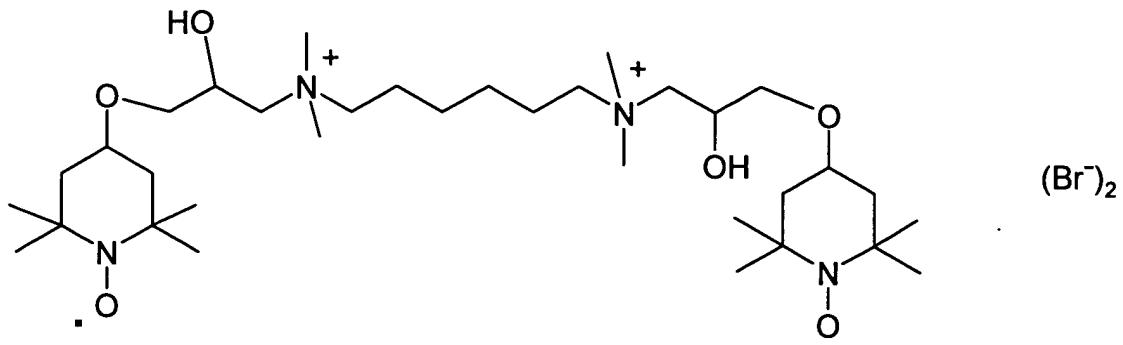
In view of this discussion and the Cunkle Declaration, Applicants submit that the 35 USC 112, first paragraph rejections and the 35 USC 132 objections are addressed and are overcome.

Claims 1-10 stand rejected as obvious under 35 USC 103(a) over WO 99/05108.

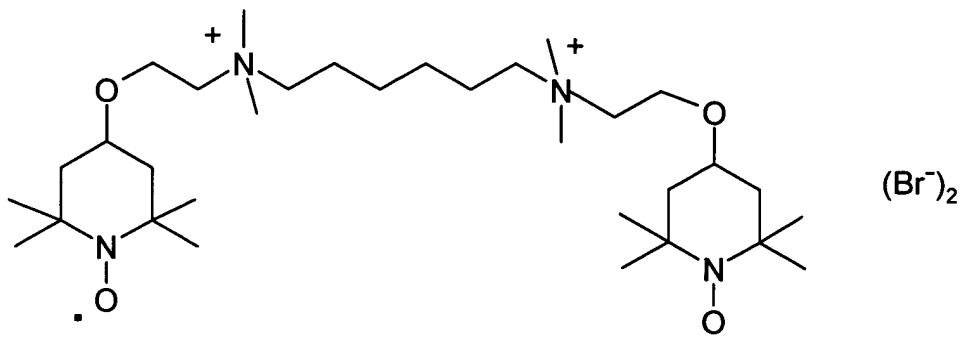
Applicants respectfully traverse these rejections.

The Examiner states that compound (g) on page 55 of WO '108 is N,N,N',N'-tetramethyl-N,N'-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-**propyl**]-hexamethylenediammonium dibromide. It is not, but rather is N,N,N',N'-tetramethyl-N,N'-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-**2-hydroxypropyl**]-hexamethylenediammonium dibromide.

The structure of compound (g) of WO '108 is provided below:



The present compound of working Example 18, N,N,N',N'-tetramethyl-N,N'-bis-[3-(1-oxyl-2,2,6,6-tetramethylpiperidin-4-yloxy)-ethyl]-hexamethylenediammonium dibromide, is:



The present compounds of formula VIII do not have any secondary hydroxy groups as does this compound. There is no overlap of the compound (g) of page 55 of WO '108 with the compounds of the present claims. Alkylene groups with secondary hydroxy groups are not analogous to the present straight chain alkylene groups (ethylene in this case). The specific compound of WO '108 cited by the Examiner is completely different from the compound of present Example 18.

Further, there is no possible overlap of the compounds of the present claims with any of the compounds of formulae A to EE and A* to EE* disclosed in WO '108.

In light of the fact that there is no possible overlap of the compounds of the present claims with the disclosure of WO '108, Applicants submit that the present claims cannot be obvious thereover.

In view of this discussion, Applicants submit that the 35 USC 103(a) rejections of the claims are addressed and are overcome.

In view of the present discussion, Applicants submit that each of the claim rejections under 35 USC 112, first paragraph and 35 USC 103(a), and claim objections under 35 USC 132 are addressed and are overcome.

The Examiner is kindly requested to reconsider and to withdraw the present rejections.

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

Information Disclosure Statement

Applicants take this opportunity to submit disclosures of the above discussed commonly assigned patent families for consideration.

A copy of PTO form 1449 is attached. The Examiner is kindly requested to indicate that each reference was considered by returning an initialed copy of form 1449.

The disclosure of Family 1 is already of record, WO 99/05108 and equivalent U.S. Pat. No. 6,254,724.

U.S. published application No. 2002/0088574 is submitted herewith (disclosure of Family 2).

U.S. Pat. No. 6,599,326 is submitted herewith (disclosure of Family 3).

A copy of U.S. application No. 09/483,017 is submitted herewith (Family 4).

A copy of U.S. Pat. No. 6,187,387 is attached herewith (Family 6).

Respectfully submitted,



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Attachments: PTO form 1449

U.S. published application No. 2002/0088574

U.S. Pat. No. 6,599,326

copy of U.S. application No. 09/483,017, filed Jan. 13, 2000

U.S. Pat. No. 6,187,387